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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,414	04/03/2001	Alan Collmer	19603/3243 (CRF D-2601C)	2043

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EXAMINER

MAYES, LAURIE A

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 02/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/825,414

Applicant(s)

COLLMER ET AL.

Examiner

Laurie Mayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-9 is/are rejected.
- 7) ☒ Claim(s) 7-9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Applicant's election with traverse of claims 7-9 in Paper No. 8 is acknowledged. The traversal is on the ground(s) that the claims are closely related and therefore require common areas of search and consideration. The applicant also argues that SEQ ID NOS: 7 and 66 should be examined together because they are closely related as evidenced by their 78% alignment match. This is not found persuasive because the claims are not closely related. The claims are drawn to distinct inventions such as an expression system comprising nucleic acids, cells and transformed plants, a protein, a method of transforming a plant with a nucleic acid, a method of preventing disease in plants by administering a protein, methods of making a plant hypersusceptible to colonization by bacteria by transformation with nucleic acids or proteins, and methods of inducing cell death with a protein, a method of treating cancer with a protein and nucleic acid. SEQ ID NO: 7 and SEQ ID NO: 66 differ by 22% and result in different structures and functions and are different inventions. Therefore, the restriction requirement is still deemed proper and is therefore made FINAL.

Claims 1-6 and 10-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected claims, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8.

Claim Objections

Claims 7-9 are objected to as being dependent from non-elected claims. Please rewrite claim 7 in appropriate independent format.

SEQ ID NO: 7 was disclosed in the earlier application filed on April 4, 2000 and is therefore entitled to the April 4, 2000 priority date.

Claim 8 is objected to because of the following informalities: claim 8 uses the language "SEQ.ID. No. ____". The use of more than one period in a claim is not permitted. The applicant may rewrite this language as follows: "SEQ ID NO: ____". Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Charkowski et al. Charkowski et al. teach that among the extracellular proteins found and isolated from *Pseudomonas syringae* pv. tomato DC3000 in a prior experiment is the protein HopPtoA which is encoded by the hopPtoA gene (Charkowski et al., lines 7-12). SEQ ID NO: 7 of claims 7 and 8 is the amino acid sequence for the protein encoded by HopPtoA (see specification p. 21). Therefore, the protein comprising SEQ ID NO:7 in claims 7 and 8 are anticipated by Charkowski et al.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yuan et al. (J. Bacteriology, V. 178, No. 21, p. 6399-6402 (1996)) in view of Charkowski et al (Phytopathology 87 (6 Suppl.): pS17 (1997)). Yuan et al. discloses that *Pseudomonas syringae* pv. tomato DC 3000 produces seven to eight major extracellular proteins in a medium inducing hrp genes (p. 6399, 1st para. summary). Yuan et al. determined the N-terminal amino acid sequence of a 60 kDa protein secreted by the Hrp system (p. 6399, col. 1, last para. and p.6400, col. 2, second para.). Yuan et al. also disclose these extracellular proteins in a carrier, namely, a medium fraction (p. 6400, col. 2, 1st para.) and disclose that these proteins play a role in regulating the hypersensitive response in plants (p. 6399, col. 1, 1st para.). Yuan et al. fails to specifically disclose that the protein HopPtoA which is encoded by the hopPtoA gene is one the extracellular proteins found. Charkowski et al. do disclose that among the extracellular proteins found is the protein HopPtoA which is encoded by the hopPtoA gene (Charkowski et al., lines 7-12). SEQ ID NO: 7 of claims 7-9 is the amino acid sequence for the protein encoded by HopPtoA (see specification p. 21). It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to add a carrier to the protein for laboratory purposes as taught in Yuan et al. or to regulate the hypersensitive response (HR) in plants as Yuan et al. teach the role of this protein in such HR regulation.

No claim is allowed.

Charkowski et al. (J. Bacteriology, V180, N. 19, 1998, p. 5211-5217; see IDS paper # 5) is cited as disclosing that the peptide disclosed in the Charkowski et al. reference from the Phytopathology journal has the identical sequence of SEQ ID NO: 7, and the Charkowski et al.

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Journal of Bacteriology reference refers to the material of the Charkowski et al. from the Phytopathology journal reference. (See J. Bacteriology at page. 5217.)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Mayes whose telephone number is (703) 605-1208. The examiner can normally be reached on Monday through Friday from 7 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (703) 305-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1123.



Laurie Mayes
Patent Examiner
Art Unit 1653
February 6, 2003



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